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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,254	09/12/2003	John Moon	CV-0043	8705

7590 12/27/2005  
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EXAMINER

LAVARIAS, ARNEL C

ART UNIT PAPER NUMBER

2872

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/661,254	<b>Applicant(s)</b> MOON ET AL.	
	<b>Examiner</b> Arnel C. Lavarias	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/13/05, 12/22/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-45, 47 and 54-77 is/are rejected.
- 7) ☒ Claim(s) 46 and 48-53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/22/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/13/05 has been entered.

### ***Drawings***

2. The drawings were received on 2/16/05. These drawings are objected to for the following reason(s) as set forth below.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:  
Figure 4- Reference numeral 842.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:  
Figure 5- Reference numeral 203 (See Page 14, lines 14, 16).
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version

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of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Response to Amendment***

6. The amendments to the specification of the disclosure in the submission dated 10/13/05 are acknowledged and accepted.
7. The amendments to Claims 21, 28, 30, 45, 47, 60, 62, and 77 in the submission dated 10/13/05 are acknowledged and accepted.

***Response to Arguments***

8. The Applicants did not provide any arguments or remarks regarding the rejections made in Sections 11-19 of the Office Action dated 5/10/05.
9. It is also noted that, based on the amendments made to Claims 21 and 47, the provisional double patenting rejections in Sections 12-13 of the Office Action dated 5/10/05 have not been withdrawn since the amendments are very similar in scope to the recent amendments made to the claims in copending Application Nos. 10/661082 and 10/661031.
10. Claims 21-45, 47, 54-77 are now rejected as follows.

*Double Patenting*

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 21-45, 47, 54-77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 20-31, 40-41, 46-51, 53-69, 78-79, 84-89, 91-135 of copending Application No. 10/661031. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661031 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical on a substrate, as set forth in Claims 21-45, 47, 54-77 of the instant application. It is noted that ‘a chemical’ (See for example Claim 20 of copending Application No. 10/661031) would encompass those chemicals that are both synthetic and naturally occurring. Further, it would have been readily apparent and obvious to one

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having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 21-44, 47, 54-76 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 24-60, 71-74 of copending Application No. 10/661082. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/661082 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical on a substrate, as set forth in Claims 21-44, 47, 54-76 of the instant application. Further, it is noted that 1) the recited 'item' (See for example Claim 24 of copending Application No. 10/661082) generally corresponds to the synthesized chemical as recited in the instant application, 2) it would have been readily apparent and obvious to one having ordinary skill in the art that in attaching the synthesized chemical to at least a portion of the substrate, one may view either the synthesized chemical being disposed on the substrate, or conversely the substrate being disposed on the synthesized chemical, and 3) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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14. Claims 21-26, 28, 35, 47, 54-58, 60, 67 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 20, 26-31, 34-41, 44 of copending Application No. 10/763995. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/763995 similarly recites an optical identification element having a synthesized chemical attached thereto and a method of synthesizing a chemical on a substrate, as set forth in Claims 21-26, 28, 35, 47, 54-58, 60, 67 of the instant application. Further, it is noted that 1) the recited solution (See for example Claim 20 of copending Application No. 10/763995) generally corresponds to the synthesized chemical as recited in the instant application, and 2) it would have been readily apparent and obvious to one having ordinary skill in the art to perform the methods of synthesizing a chemical on a substrate based on the recited structure provided for the optical identification element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

15. Claims 46, 48-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arnel C. Lavarias  
Patent Examiner  
Group Art Unit 2872  
12/22/05